



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/884,531 | 06/19/2001 | Brian McConnell | 310/1 | 2612 |
| 27538 | 7590 | 01/11/2005 | EXAMINER | |
| KAPLAN & GILMAN, L.L.P. 900 ROUTE 9 NORTH WOODBIDGE, NJ 07095 | | | BHATIA, AJAY M | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2145 | |

DATE MAILED: 01/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicant(s)

09/884,531

Applicant(s)

MCCONNELL ET AL.

Examiner

Ajay M Bhatia

Art Unit

2145

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 January 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

1. Claims 1-10 are pending.
2. Claims 1-10 are rejected.

Drawings

3. The drawings are objected to because figure 12A and 12B both are cut off slightly at the bottom of the page. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

4. Applicant is advised that should claim 4 be found allowable, claim 5 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two

Art Unit: 2145

claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Woltz et al. (US Patent 5,995,597 referred to as Woltz) in view of Ron et al. (US Patent 6,775,359 referred to as Ron).

6. For claim 1, Woltz teaches,

- (a) receiving a text email message; (See Woltz, Col. 3 lines 18-28)
- (b) parsing the name of an intended recipient; (See Woltz, Col. 3 line 59 to Col. 4 line 2)
- (c) determining if the intended recipient is an authorized user; (See Woltz, Col. 3 lines 29-40)
- (d) if the intended recipient is authorized, assigning a message-specific indicia to the message; (See Woltz, Col. 5 lines 25-41)

Art Unit: 2145

(e) if the intended recipient is authorized, appending a reply notice with the message-specific indicia to the message; (See Woltz, Col. 5 lines 25-41)

(f) if a reply notice is appended, saving the email message with the reply notice appended thereto; and (See Woltz, Col. 5 lines 25-41)

(g) if the intended recipient is authorized, transmitting the email message with the reply notice to the intended recipient. (See Woltz, Col. 5 lines 25-41)

Woltz fails to teach, a method for enabling a user of a portable electronic device to communicate with a user of an office-based terminal by voice, comprising the steps of:

Ron teaches, a method for enabling a user of a portable electronic device to communicate with a user of an office-based terminal by voice, comprising the steps of:
(See Ron, Col. 4 lines 57-67)

(e) if the intended recipient is authorized, appending a reply notice with the message-specific indicia to the message; (See Ron, Col. 6 lines 24-34)

It would be obvious of one of ordinary skill in the art at the time of the invention to combine the system of Woltz with the method of Ron because both are providing ways of improving the retrieval and response to e-mail when away from the home or office workstation. (See Woltz, Col. 2 lines 37-55) and (See Ron, Col. 2 lines 40-55)

Art Unit: 2145

7. For claim 2, Woltz-Ron teaches, the method for enabling a user of a portable electronic device to communicate with a user of an office-based terminal by voice according to claim 1, further comprising the step of rejecting the email message if the intended recipient is not authorized. (See Woltz, Col. 5 lines 25-41) The same motivation that was utilized in the rejection of claim 1, applies equally as well to claim 2.

8. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Woltz et al. (US Patent 5,995,597 referred to as Woltz) in view of Ron et al. (US Patent 6,775,359 referred to as Ron) in further view of Okada et al. (US Patent 6,463,134 referred to as Okada).

9. For claim 3, Woltz teaches,

(a) extracting message header information from a received text email message; (See Woltz, Col. 3 line 59 to Col. 4 line 2)

(b) dividing the message header information into components thereof; (See Woltz, Col. 3 line 59 to Col. 4 line 2)

(c) analyzing the components of the message header; (See Woltz, Col. 3 line 59 to Col. 4 line 2)

Woltz fails to teach,

a method for enabling a user of a portable electronic device to communicate with a user of an office-based terminal by voice, comprising the steps of:

Art Unit: 2145

- (d) assigning a message-specific indicia to the message;
- (e) appending a reply notice comprising an instruction to the recipient that in order to reply to the text email by phone the recipient must initiate a telephone call to a selected phone number and enter the assigned message-specific indicia;
- (f) saving the email message with the reply notice appended thereto; and
- (g) transmitting the email message with the reply notice to the intended recipient.

Ron teaches, a method for enabling a user of a portable electronic device to communicate with a user of an office-based terminal by voice, comprising the steps of:

(See Ron, Col. 4 lines 57-67)

- (d) assigning a message-specific indicia to the message; (See Ron, Col. 4 lines 57-67)

It would be obvious of one of ordinary skill in the art at the time of the invention to combine the system of Woltz with the method of Ron because both are providing ways of improving the retrieval and response to e-mail when away from the home or office workstation. (See Woltz, Col. 2 lines 37-55) and (See Ron, Col. 2 lines 40-55)

Okada teaches, (e) appending a reply notice comprising an instruction to the recipient that in order to reply to the text email by phone the recipient must initiate a telephone call to a selected phone number and enter the assigned message-specific indicia; (See Okada, Col. 13 lines 25-35)

Art Unit: 2145

(f) saving the email message with the reply notice appended thereto; and (See Okada, Col. 13 lines 1-8)

(g) transmitting the email message with the reply notice to the intended recipient. (See Okada, Col. 13 lines 1-8)

It would be obvious of one of ordinary skill in the art at the time of the invention to combine the system of Woltz with the method of Ron and the method of Okada because they are providing ways of improving the retrieval and response to e-mail when away from the home or office workstation. (See Woltz, Col. 2 lines 37-55), (See Ron, Col. 2 lines 40-55) and (See Okada, Col. 1 lines 4-11)

10. Claim 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Woltz et al. (US Patent 5,995,597 referred to as Woltz) in view of Ron et al. (US Patent 6,775,359 referred to as Ron) in further view of Okada et al. (US Patent 6,463,134 referred to as Okada) and Cooper et al. (US Patent 6,757,362 referred to as Cooper).

11. For claim 4, Woltz-Ron-Okada fails to teach, the method for enabling a user of a portable electronic device to communicate with a user of an office-based terminal by voice according to claim 3, further comprising the step of determining whether the name and email address of the sender of the email message are recorded in an address list, and, if not, entering the name and address thereof.

Art Unit: 2145

Cooper teaches, the method for enabling a user of a portable electronic device to communicate with a user of an office-based terminal by voice according to claim 4, further comprising the step of determining whether the name and email address of the sender of the email message are recorded in an address list, and, if not, entering the name and address thereof. (See Cooper, Col. 5 lines 5-15)

It would be obvious of one of ordinary skill in the art at the time of the invention to combine the system of Woltz-Ron-Okada with the method of Cooper, because they Cooper provides an enhanced voice interface to interact with the user improving upon Woltz-Ron-Okada. (See Woltz, Col. 2 lines 37-55), (See Ron, Col. 2 lines 40-55), (See Okada, Col. 1 lines 4-11) and (See Cooper, Col. 2 lines 45-65)

12. For claim 5, Woltz-Ron-Okada fails to teach, the method for enabling a user of a portable electronic device to communicate with a user of an office-based terminal by voice according to claim 3, further comprising the step of determining whether the name and email address of the sender of the email message are recorded in an address list, and, if not, entering the name and address thereof.

Cooper teaches, the method for enabling a user of a portable electronic device to communicate with a user of an office-based terminal by voice according to claim 4, further comprising the step of determining whether the name and email address of the

Art Unit: 2145

sender of the email message are recorded in an address list, and, if not, entering the name and address thereof. (See Cooper, Col. 5 lines 5-15)

The same motivation that was utilized in the rejection of claim 4, applies equally as well to claim 5.

13. Claims 6, 7, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ron et al. (US Patent 6,775,359 referred to as Ron) in view of Okada et al. (US Patent 6,463,134 referred to as Okada).

14. For claim 6, Ron teaches, a method for enabling a user of a portable electronic device to communicate with a user of an office-based terminal by voice, comprising the steps of: (See Ron, Col. 4 lines 57-67)

(a) receiving a call in an email server from the user of the portable electronic device;
(See Ron, Col. 4 lines 51-67)

(c) obtaining a pre-assigned message-identifying code from the caller; (See Ron, Col. 6 lines 24-34)

(d) authenticating the message-identifying code; (See Ron, Col. 6 lines 24-34)

(e) requesting the caller to record a voice message; (See Ron, Col. 4 lines 57-67)

(f) recording the voice message; and (See Ron, Col. 4 lines 57-67)

(g) transmitting the voice message to the user of the office-based terminal. (See Ron, Col. 4 lines 51-67)

Art Unit: 2145

Ron fails to teach, (b) determining if the caller is registered as a user of the email server;

Okada teaches, (b) determining if the caller is registered as a user of the email server;

(See Okada, Col. 13 lines 1-8)

It would be obvious of one of ordinary skill in the art at the time of the invention to combine the system of Ron with the method of Okada because they are providing ways of improving the retrieval and response to e-mail when away from the home or office workstation. (See Ron, Col. 2 lines 40-55) and (See Okada, Col. 1 lines 4-11)

15. For claim 7, Ron-Okada teaches, the method for enabling a user of a portable electronic device to communicate with a user of an office-based terminal by voice according to claim 6, further comprising the step of converting the recorded voice message into a format adapted for attachment to an electronic message. (See Ron, Col. 4 lines 51-67) The same motivation that was utilized in the rejection of claim 6, applies equally as well to claim 7.

16. For claim 9, Ron-Okada teaches, the method for enabling a user of a portable electronic device to communicate with a user of an office-based terminal by voice according to claim 6, further comprising the step of determining if the recorded message is acceptable and if not, recording the message again. (See Ron, Col. 5 line 60 to Col. 5

Art Unit: 2145

line 8)The same motivation that was utilized in the rejection of claim 6, applies equally as well to claim 9.

17. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ron et al. (US Patent 6,775,359 referred to as Ron) in view of Okada et al. (US Patent 6,463,134 referred to as Okada) in further view of Cooper et al. (US Patent 6,757,362 referred to as Cooper).

18. For claim 8, Ron-Okada fails to teach, the method for enabling a user of a portable electronic device to communicate with a user of an office-based terminal by voice according to claim 6, further comprising the steps of playing an error message and terminating the program if the caller is not registered as a user of the email server.

Cooper teaches, the method for enabling a user of a portable electronic device to communicate with a user of an office-based terminal by voice according to claim 6, further comprising the steps of playing an error message and terminating the program if the caller is not registered as a user of the email server.

It would be obvious of one of ordinary skill in the art at the time of the invention to combine the system of Ron-Okada with the method of Cooper, because they Cooper provides an enhanced voice interface to interact with the user improving upon Ron-

Art Unit: 2145

Okada. (See Ron, Col. 2 lines 40-55), (See Okada, Col. 1 lines 4-11) and (See Cooper, Col. 2 lines 45-65)

19. For claim 10, McAllister teaches, (g) converting the recorded voice message into MP-3 format;

McAllister fails to teach,

a method for enabling a user of a portable electronic device to communicate with a user of an office-based terminal by voice, comprising the steps of:

- (a) receiving a call in an email server from the user of the portable electronic device;
- (b) determining if the caller is registered as a user of the email server;
- (c) obtaining a pre-assigned message-identifying code from the caller;
- (d) authenticating the message-identifying code;
- (e) requesting the caller to record a voice message;
- (f) recording the voice message;
- (h) transmitting the voice message to the user of the office-based terminal.

Ron teaches, a method for enabling a user of a portable electronic device to communicate with a user of an office-based terminal by voice, comprising the steps of:

(See Ron Col. 4 lines 57-67)

- (a) receiving a call in an email server from the user of the portable electronic device;

(See Ron Col. 4 lines 57-67)

Art Unit: 2145

(b) determining if the caller is registered as a user of the email server; (See Ron Col. 6 lines 24-34)

(c) obtaining a pre-assigned message-identifying code from the caller; (See Ron Col. 6 lines 24-34)

(d) authenticating the message-identifying code; (See Ron Col. 6 lines 24-34)

(e) requesting the caller to record a voice message; (See Ron Col. 4 lines 57-67)

(f) recording the voice message; and (See Ron Col. 4 lines 57-67)

(h) transmitting the voice message to the user of the office-based terminal. (See Ron Col. 5 lines 5 to Col. 6 line 8)

Woltz teaches,

(b) determining if the caller is registered as a user of the email server; (See Woltz, Col. 5 lines 25-41)

(c) obtaining a pre-assigned message-identifying code from the caller; (See Woltz, Col. 5 lines 25-41)

(d) authenticating the message-identifying code; (See Woltz, Col. 5 lines 25-41)

It would be obvious of one of ordinary skill in the art at the time of the invention to combine the system of McAllister with the method of Ron and the method of Woltz because they are providing ways of improving the retrieval and response to message when away from the home or office workstation. (See Woltz, Col. 2 lines 37-55), (See Ron, Col. 2 lines 40-55) and (See McAllister, Col. 1 lines 22-33)

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Yoshihiko (JP02001154935A) defines a mail management system that makes use of serial numbers to keep track of the e-mails.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Shively (US Patent Publication 20010039187) teaches a system for responding to pages with voice responses.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Noh et al. (US Patent Publication 20010051896) teaches a method of amending a gift certificate to a message.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Stead (US Patent Publication 20020002627) discloses a phone that interfaces with the network.

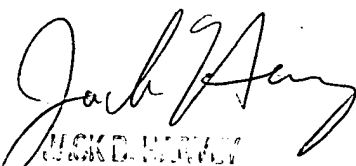
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ajay M Bhatia whose telephone number is (571)-272-3906. The examiner can normally be reached on M-F 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Harvey can be reached on (571)-272-3896. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2145

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AB


JACK H. HARGIS
SUPERVISOR, PATENT EXAMINER